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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/575,864	05/19/2000	Toshio Inadate	450100-02508	1674
20999	7590	11/16/2004	EXAMINER	
FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151			TRAN, TONGOC	
			ART UNIT	PAPER NUMBER
			2134	

DATE MAILED: 11/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	09/575,864		INADATE, TOSHIO	
	<b>Examiner</b>		<b>Art Unit</b>	
	Tongoc Tran		2134	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 August 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4,7 and 9-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4,7 and 9-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                                                        |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                            | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

### **DETAILED ACTION**

1. This Office Action is in response to Applicant's Request for Continued Examination (RCE) filed on 8/18/2004. Claims 1 and 7 are amended. Claims 5-6, 8 and 12 are canceled. Claims 1-4, 7 and 9-11 are pending.

### ***Response to Arguments***

2. Applicant's arguments with respect to the amended claims have been considered but are moot in view of the new ground(s) of rejection.

In response to applicant's argument against the reference individually, one can not show nonobviousness by attacking reference individually where the rejections are based on combination of references. See *In re Keller*, 642 F. 2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F. 2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 7 and 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. (U.S. Patent No. 5,862,223, hereinafter Walker) in view of Knee et al. (U.S. Patent No. 5,589,892, hereinafter Knee) and further in view of Luke et al. (U.S. Patent No. 6,131,087, hereinafter Luke).

Walker discloses an information processing apparatus connected to a plurality of information terminal by way of a network, comprising (see Fig. 1-3):

Storing means for recording a request information (see col. 14, lines 42-50);

Authenticating means for authenticating a user based on said user information stored in said storing means (see col. 10, lines 26-43);

Recording means for recording a request information transmitted by a first user authenticated by said authenticating means; wherein said first user is a customer and said request information is a request for an offer to sell services matching the request to said customer (see col. 10, lines 26-43 and col. 14, lines 50-60);

Supplying means for supplying a service list of said request information recorded by said recording means to a second user authenticated by said authenticating means in response to a demand entered from said second user; Said recording means recording service information transmitted by said second user in response to the request information in said service list; wherein said second user is a shop and said service information is said offer (see col. 27, lines 4-58);

Searching means for searching for service information corresponding to said request information and said user information of said second user recorded by said recording means, in response to a demand for a request list from said first user; and transferring means for transferring said request list to said user (see col. 7, lines 30-35 and lines 67-col. 8, line 1).

Walker does not explicitly disclose wherein said request list includes a mark which expresses the existence of service information corresponding to the request

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information. However, Knee discloses user receives listing with an asterisk or "star" icon indicating that a product or service associated with each of the listing is available and may be ordered remotely by the user (see Knee, col. 36, lines 67-col. 37, line 9). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate Walker's matching services with Knee's teaching of providing a mark as an indicator of service availability. Furthermore, Walker does not explicitly teach that said matching is for a request for offer to sell goods and the second user is a shop. However, Luke discloses a matching system for electronic commerce for request and offer to sell goods (see Luke, col. 1, lines 13-30, it is inherent that user offers of selling goods encompasses shop or store or business). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Walker's matching of services with Luke's matching of goods in order to accommodate the broader needs in the electronic commerce which is goods as well as services.

In respect to claim 2, Walker, Knee and Luke disclose an information processing apparatus as claimed in claim 1. Walker further discloses "said user information includes an user ID, a password and an electronic mail address" (see col. 14, lines 42-49).

In respect to claim 3, Walker, Knee and Luke disclose an information processing apparatus as claimed in claim 2. Walker further discloses "said transferring means transfers said service information corresponding to said request information as said search result to the information terminal of said first user by an electronic mail based on

said information terminal of said first user by an electronic mail based on said user information for the first user stored in said storing means" (see col. 7, lines 26-29)).

In respect to claim 4, Walker, Knee and Luke disclose an information processing apparatus as claimed in claim 3. Walker further discloses "said service information includes an address information on the network for obtaining a desired information among said service information by said first user" (see col. 18, lines 63-65).

In respect to claims 7 and 9-11, the claim limitations are method claims that are substantially similar to the apparatus claims 1-4. Therefore, claims 7 and 9-11 are rejected based on the similar rationale.

### ***Conclusion***

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

-Shear et al. Disclose systems and methods for matching, selecting, narrowcasting and/or classifying based on rights management and/or other information.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tongoc Tran whose telephone number is (571) 272-3843. The examiner can normally be reached on 8:30-5:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory A. Morse can be reached at (571) 272-3838. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.


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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-9600.

Examiner Tongoc Tran  
Art Unit: 2134

TT

  
October 26, 2004

  
GREGORY MORSE  
SUPERVISOR, PATENT EXAMINER  
TECHNOLOGY CENTER 2100